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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,633	04/06/2005	Yvonne Lichte	PAT-00376	8440

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BASF CORPORATION
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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT	PAPER NUMBER
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1792

NOTIFICATION DATE	DELIVERY MODE
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03/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/531,633	Applicant(s) LICHTE ET AL.	
	Examiner Elena Tsoy Lightfoot	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 and 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-14 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on January 23, 2009 has been entered. New claims 25-28 have been added. Claim 2 has been canceled. Claims 1, 3-10, 12-17 and 19-28 are pending in the application. Claims 15-17 and 19-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Rejection of claim 12 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of antimony tin mixed oxide coated mica as electrically conductive pigment does not reasonably provide enablement for mica as electrically conductive pigment has been withdrawn due to amendment.

Double Patenting

3. Rejection of claims 1-6 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-17 of U.S. Patent No. 6835759 has been withdrawn due to filing a proper terminal disclaimer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Rejection of claims 1-6 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palazzotto et al (US 5,326,621) and Zador et al (US 4,642,126), and applied as evidence Dunnivant et al (US 4526219) has been withdrawn due to amendment.

7. Claims 1-9, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al and Zador et al, and applied as evidence Dunnivant et al.

The cited prior art is applied here for the same reasons as set forth in paragraph 8 and 9 of the Office Action mailed on 10/23/2008.

As to claimed group (a12), Palazzotto et al teaches that suitable compounds containing at least one ethylenically-unsaturated double bond, can be monomers and/or oligomers such as pentaerythritol **tri**acrylate, pentaerythritol **tetra**acrylate (See column 7, lines 37-38) and acrylated oligomers as described by Zador et al (See column 7, lines 46-47). Zador et al discloses that acrylated oligomers may be prepared by reacting linear polyester polyol core that is *terminated* with toluene diisocyanate, with 2-hydroxyethyl acrylate (See Patent '126, column 4,

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lines 41-44). Zador et al does not explicitly disclose whether all hydroxyl groups of the polyester polyol core or only some of the OH groups were reacted with toluene diisocyanate such that some hydroxyl groups (claimed isocyanate-reactive group a12) were left unreacted.

However, Palazzotto et al teaches that suitable ethylenically-unsaturated monomers include acrylated polyol such as acrylated pentaerythritol where either *all* four OH groups are substituted with acrylate groups (pentaerythritol **tetra**acrylate) *or* only three OH groups are substituted with acrylate groups (pentaerythritol **tri**acrylate) such that one OH group is left unreacted, obviously, acrylated oligomers may also contain unreacted OH groups since Zador et al does not require that all OH groups should be reacted.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used acrylated oligomers of Zador et al containing free OH groups (claimed group (a12)) since Palazzotto et al teaches that ethylenically-unsaturated compounds may or may not contain free OH groups, and Zador et al does not require that all OH groups should be reacted.

As to claim 25, Palazzotto et al teaches that organometallic compound and an onium salt may be used as a curing agent (claimed drying catalyst) (See column 2, lines 56-60).

As to claims 27-28, it is the Examiner's position that a coating material of the cited prior art would have claimed properties since it would be substantially identical to that of claimed invention.

8. Claims 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al, Zador et al and Dunnavant et al, as applied above, and further in view of Bastian

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et al (DE 4011867) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 10/23/2008.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al, Zador et al and Dunnavant et al, as applied above, and further in view of Galla et al (US 4582861), and further in view of Schwarte et al (WO0134674).

Examiner Note: for convenience, instead of WO0134674 in German language, the Examiner will refer to US 6602972 of the same patent family.

Palazzotto et al teaches that thermal curing of polyurethane precursors using reaction promoters such as **tin salts** and tertiaryamines is known in the art. Curing of polymerizable mixtures of polyisocyanates with polyols (referred to as polyurethane precursors) using thermally latent catalysts is known in the art (see for example 4,582,861) (See column 1, lines 32-38) to Galla et al such as *dibutyltin dilaurate* catalyst (See Galla et al, column 5, lines 32-33).

Palazzotto et al and Galla et al fail to teach that *lithium salt* is used instead of dibutyltin dilaurate.

However, Schwarte et al teaches that crosslinking catalysts such as **dibutyltin dilaurate**, **lithium decanoate** or zinc octoate, or amine-blocked organic sulfonic acids (See column 24, lines 30-33) may be used for curing a polyisocynate containing composition (See column 23, lines 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used lithium decanoate as a crosslinking catalyst for curing a polyisocynate containing composition of Palazzotto et al and Galla et al instead of dibutyltin dilaurate with the expectation of providing the desired promoted curing since Schwarte et al

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teaches that crosslinking catalysts such as dibutyltin dilaurate and lithium decanoate may be used for curing a polyisocyanate containing composition.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3-10, 12-14, and 25-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

March 9, 2009

/Elena Tsoy Lightfoot/